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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,002 11/09/2000		11/09/2000	Minegishi Yukio	99564.002001	5998
22511	7590	11/27/2002			
ROSENTHAL & OSHA L.L.P. 1221 MCKINNEY AVENUE SUITE 2800			EXAMINER		
				FERNSTROM, KURT	
HOUSTON, TX 77010		10	ART	ART UNIT	PAPER NUMBER
				3712	
				DATE MAIL ED: 11/27/2002	

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)				
	09/711,002	YUKIO ET AL.				
Office Action Summary	Examiner	Art Unit				
	Kurt Fernstrom	3712				
The MAILING DATE of this communication appears on the cover shet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status  1) ■ Responsive to communication(s) filed on 23 S	Santambar 2002					
	-					
<u>'</u>	s action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims						
4)⊠ Claim(s) <u>8-17</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>8-17</u> is/are rejected.						
7) Claim(s) is/are rejected.						
<u> </u>						
8) Claim(s) are subject to restriction and/or election requirement.  Application Papers						
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accept	oted or b) objected to by the Exar	miner.				
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.						
If approved, corrected drawings are required in reply to this Office action.						
12) The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents	s have been received.					
2. Certified copies of the priority documents	s have been received in Application	on No				
Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.						
·						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  a) ☐ The translation of the foreign language provisional application has been received.						
15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.						
Attachment(s)						
<ol> <li>Notice of References Cited (PTO-892)</li> <li>Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>Information Disclosure Statement(s) (PTO-1449) Paper No(s)</li> </ol>	5) Notice of Informal F	(PTO-413) Paper No(s) Patent Application (PTO-152)				

Serial Number: 09/711002

Art Unit: 3712

#### **DETAILED ACTION**

### Claim Rejections - 35 USC § 101

- 1. 35 U.S.C. 101 reads as follows:
  - Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
- 2. Claims 8-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a medium upon which is provided a plurality of "thought units," each of which displays a plurality of "thought results." The "thought results" appear to be the thoughts of various participants of a meeting, which are not patentable subject matter.

The Federal Circuit has applied the practical application test to determine whether claimed subject matter is patentable under 35 USC 101. *ATT Corp. V. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. V. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). The test for practical application requires that a "useful, concrete and tangible result" be accomplished. The present invention does not meet the last two requirements of the test, that is; it does not produce a result which is concrete or tangible. The thoughts of a person are subjective and indefinite, and not tangible or concrete.

Serial Number: 09/711002 Page 3

Art Unit: 3712

## Claim Rejections - 35 USC § 112

- 3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
  - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- 4. Claims 8-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Because the invention does not produce a concrete or tangible result, the invention cannot operate as intended without undue experimentation. Also, the term "thought results" has not been described in the specification in such a way as to make clear to a user how that term is defined. In fact, the specification asserts on page 9, lines 4-5 that "[t]he relationship between the subject and the thought results has no limitation."

Because the scope of the claims is very unclear, no examination of the claims in view of the prior art has been performed at this time.

Serial Number: 09/711002

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Art Unit: 3712

# Response to Arguments

5. Applicant's arguments with respect to claims 8-17 have been considered but are moot in view of the new ground(s) of rejection.

### Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

November 22, 2002

Kien T. Nguyan